
To: Allied Electronics Inc. (evonvorys@srgpe.com)
Subject: TRADEMARK APPLICATION NO. 78132209 - ALLIED
ELECTRONICS - 105363.00007
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Attachments: Attachment - 1
Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/132209

APPLICANT: Allied Electronics Inc.

CORRESPONDENT ADDRESS:

Eric J. von Vorys
Shulman Rogers Gandal Pordy & Ecker, P.A
11921 Rockville Pike, Suite 300
Rockville MD 20852

78132209
**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: ALLIED ELECTRONICS

CORRESPONDENT'S REFERENCE/DOCKET NO:
105363.00007

CORRESPONDENT EMAIL ADDRESS:
evonvorys@srgpe.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark ALLIED ELECTRONICS for "hand tools for use in the electronics industry, namely hand-held crimpers, wire cutters, lead cutters, wire strippers, extractors for electrical and computer components, tweezers, punchdown tools, blow torches and metal vices" in International Class 8. Registration was refused, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), based on the likelihood of confusion with the mark ALLIED, Registration No. 0568267, for "hand- and machine-tools; namely, files, drill bits, trowels, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, taps and dies" in International Class 8.

FACTS

Applicant filed this application for registration of the mark ALLIED ELECTRONICS on the Principal Register on May 30, 2002. In the original application, Applicant identified the goods as "hand tools, namely hand-held crimpers, punches, wire cutters, wrenches, lead cutters, pliers, wire strippers, extractors for electrical and computer components, screw drivers, tweezers, punchdown tools, blow torches, and metal vices."

The First Office Action, on October 17, 2002, refused registration, under Trademark Act § 2(d), 15 U.S.C. § 1052(d), based on the likelihood of confusion with the mark ALLIED, Registration No. 0568267, for "hand- and machine-tools; namely, files, drill bits, trowels, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, taps and dies." The refusal was based on the Examining Attorney's finding that the marks were highly similar and the goods of the parties related, and in some cases identical. In addition, Applicant was required to disclaim the descriptive wording ELECTRONICS.

Applicant responded to the First Office Action on March 5, 2003, maintaining that no source confusion was likely. In addition, Applicant agreed to the disclaimer requirement of the descriptive wording ELECTRONICS.

The Second Office Action was sent on May 14, 2003, acknowledging the addition of the disclaimer to the record, and making the likelihood of confusion refusal final.

Applicant filed an "Amendment and Request for Reconsideration" on October 27, 2003, in which Applicant amended the identification of goods by removing all goods that were, by name, identical to those identified on the registration. Applicant also maintained an argument against a likelihood of confusion for the same reasons stated in the prior response.

The Third Office Action was sent on February 25, 2004, by the new Examining Attorney (after a case reassignment), (1) superseding the outstanding final action (based on an issue with respect to the scope of the goods), (2) continuing the refusal under § 2(d), (3) attaching third-party registration evidence relating Applicant's goods and Registrant's goods, and (4) noting that an appeal at that time would be premature.

Applicant filed an amended identification of goods on June 2, 2004, and responded to the evidence included with the Third Office Action.

The Final Office Action, on July 8, 2004, accepted the amended identification and made final the § 2(d) refusal. Applicant was notified on September 14, 2004 that the appeal was resumed based upon the final refusal, and Applicant filed an Ex Parte Appeal Brief in Favor of Registration ("Applicant's Brief") on November 4, 2004.^[1]

ISSUE

The sole issue on appeal in this case is whether there is a likelihood of confusion between the mark of the applicant, ALLIED ELECTRONICS, for "hand tools for use in the electronics industry, namely, hand-held crimpers, wire cutters, lead cutters, wire strippers, extractors for electrical and computer components, tweezers, punchdown tools, blow torches and metal vices," and the mark of the registrant, ALLIED, for "hand- and machine-tools; namely, files, drill bits, trowels, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, taps and dies."

ARGUMENT

Registration of Applicant's mark has been refused because it presents a likelihood of confusion between two highly similar marks for highly similar goods. The court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under § 2(d). Any one of the factors listed may be dominant in a given case, depending upon the evidence of record. The evidence of record in this case demonstrates that the similarity of the marks and similarity of the goods are the most relevant factors to a determination of likelihood of confusion. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999); *In re L.C. Licensing Inc.*, 49 USPQ2d 1379 (TTAB 1998); TMEP §§1207.01 *et seq.* Even a "weak" mark is still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976). Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant, here the owner of the ALLIED mark. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

A. THE MARKS CREATE THE SAME COMMERCIAL IMPRESSION

Applicant has applied for the mark ALLIED ELECTRONICS in standard character form, while Registrant owns the minimally stylized mark ALLIED for related goods. ^[2] The likelihood of confusion between two marks is determined by comparing the marks for similarities in sound, appearance, meaning or commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §§1207.01(b) *et seq.* Neither the addition of a highly descriptive term to Applicant's mark, nor the slight stylization and carrier of Registrant's mark, changes the similar appearance, sound, meaning and commercial impression of these marks.

The dominant component of each mark, ALLIED, is identical. Contrary to Applicant's argument, the identical dominant portion of two marks may support a finding that a likelihood of confusion is present. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004). In *Chatam*, the court provided several citations to precedent in finding that the marks JOSE GASPAR GOLD and GASPAR'S ALE were confusingly similar based on the dominance of the GASPAR portion of each mark, as applied to tequila and ale and beer respectively.

Moreover, Applicant has presented the mark ALLIED ELECTRONICS in standard character form with no claim to "any particular font, style, size, or color," meaning that registration of Applicant's mark would allow Applicant to use the mark in any stylized form Applicant deemed desirable. 37 C.F.R. §2.52(a). Therefore, any protection afforded Registrant for its special form mark of ALLIED would be nullified if Applicant's mark were allowed to register its mark, as Applicant would be free to copy Registrant's stylized font.

The carrier in Registrant's mark, a simple single-line rectangle with no embellishments, does not obviate the similarity in commercial impression created by the use of the word ALLIED in both marks. As the Board stated in *Guess! Inc. v. Nationwide Time, Inc.*, "'ordinary geometric shapes such as circles, ovals, squares, etc.,...are regarded as non-distinctive.'" 16 USPQ2d 1804 (TTAB 1990) (quoting 1 J. McCarthy, *Trademarks and Unfair Competition*, Section 7:12 at pages 206-207 (2d ed. 1984)); *see also, Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). It is also well settled that the literal portions are the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554 (TTAB 1978). For this reason, greater weight is given to the literal portions of the marks in determining whether there is a likelihood of confusion. TMEP §1207.01(c)(ii).

Furthermore, Applicant has appropriated Registrant's mark, merely adding a highly descriptive term, ELECTRONICS, to ALLIED. The mere addition of a term to a registered mark cannot counteract the similarity between the marks, nor can it overcome a likelihood of confusion under

§ 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C. P.A. 1975). Especially here, where ELECTRONICS is highly descriptive and disclaimed matter, a mark's commercial impression will be dominated by the term ALLIED. While a disclaimed portion of a mark certainly cannot be ignored, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (holding that DELTA is the dominant portion of the mark THE DELTA CAFÉ where the disclaimed word "café" is descriptive of applicant's services); see also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002). In fact, a reasonable commercial impression arising from the addition of ELECTRONICS to the ALLIED mark is that the mark denotes a subset of Registrant's product line focused on electronics, rather than that the source of the products is a different company. The descriptive nature of the term ELECTRONICS in this case, diminishes its ability to form a sufficient lasting impression so as to prevent a likelihood of confusion.

The identical dominant element of each mark, the highly descriptive term simply added to Registrant's mark, and the fact that Applicant's standard character claim would severely restrict the protection afforded Registrant's mark, are all factors that mitigate in favor of finding a likelihood of confusion between these two highly similar marks.

B. THE GOODS ARE RELATED AND OVERLAPPING

Applicant's goods are identified as "hand tools for use in the electronics industry, namely, hand-held crimpers, wire cutters, lead cutters, wire strippers, extractors for electrical and computer components, tweezers, punchdown tools, blow torches and metal vices," and Registrant's goods are "hand- and machine-tools; namely, files, drill bits, trowels, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, taps and dies." Hence, the goods identified in both the application and the registration are various types of hand tools used for similar and/or complementary purposes, found in the same channels of trade.

Where the marks of the respective parties are identical or highly similar, the commercial relationship

between the goods or services of the respective parties must be analyzed carefully to determine whether there is a likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355 (TTAB 1983); TMEP §1207.01(a).

1. Registrant's identification of goods is not limited in use, industry or target consumer.

Registrant's goods are identified as assorted hand tools with no limitation as to an intended market or purchaser. Applicant identifies its goods as assorted hand tools "for the electronics industry." Applicant admits "the respective goods of the Applicant and those of [Registrant] are not wholly unrelated." See Applicant's Response to First Office Action, 3/5/03, p. 3.

Likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Moreover, actual use of the mark is not relevant to the scope of the identification of goods in the registration. *J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). The broad identification of Registrant's goods in the registration is presumed to encompass all goods of the type described, including those in Applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica International*, 196 USPQ 775 (TTAB 1977); TMEP §1207.01(a)(iii).

Registrant's broad identification of goods includes all channels of trade for tools including the electronics industry. Even if Registrant is not presently marketing its goods specifically to the electronics industry, any goods or services in Registrant's normal fields of expansion must also be considered in order to determine whether Registrant's goods are related to Applicant's identified goods for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983);

TMEP §1207.01(a)(v).

Both an expanded marketing of the existing product line to electronics industry customers, and/or an expanded product line within the scope of the registration, but specifically geared towards use with electronics, would be reasonable expansions of trade for Registrant. For example, Registrant has not limited the range of sizes on the tools identified in the registration, leaving open a full complement of pliers and shears, including those of types and sizes appropriate for work in the electronics industry. In addition, there is little to relate wire cutters specifically to the electronics industry, and therefore no logical reason why Registrant may not apply the ALLIED mark to wire cutters in the future. The fact that Applicant initially applied for use of the mark for tools such as pliers and screwdrivers, i.e., tools that appear both in Applicant's identification and in Registrant's identification, reinforces this overlap. See Applicant's Original Application, p. 1.

As further evidence that the goods are related, the Examining Attorney provided 32 examples of third-party registrations identifying goods that appear both in Applicant's identification and goods that appear in Registrant's identification. See Final Office Action, Attachments, 7/15/04. Third-party registrations of marks registered for use in connection with the same or similar goods as those of an applicant and a registrant have probative value to the extent that they serve to suggest that the goods listed are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001) (citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993)); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

The *Bendix Aviation Corp. v. Ardor Manuf. Co., Inc.* case, cited by Applicant in support of the argument that Applicant's goods are not related to those of Registrant, is inapposite. 141 USPQ 572 (C.C.P.A. 1964), Applicant's Brief, p. 8. In that case, the court found no likelihood of confusion between the marks BENDIT and BENDIX, where BENDIT applied to a single specific hand tool used in bending wire into pegboard hooks, and BENDIX to very specialized and expensive equipment used in the aircraft industry "for testing and analyzing electrical systems and components thereof" of

equipment manufactured by the same company (ex. diesel fuel injection pumps). The clear distinction between the goods, and the highly suggestive (BENDIT) and surname (BENDIX) matter in the marks were sufficient to prevent confusion. *Bendix*, 141 USPQ at 573.

Here, on the other hand, we have two marks that use the identical term in a dominant manner, and two companies producing hand tools with significant identical overlap such as pliers, screw drivers and punches. *See* Initial identification of goods listed in the Application, p.1; First Office Action, 10/17/02. Applicant cannot sustain any kind of serious argument that its “tweezers” and “wire cutters” are the equivalent of the BENDIX diesel fuel injection pumps and jet injection systems. Unlike in *Bendix*, Applicant’s goods and Registrant’s goods are sufficiently related to cause source confusion in the minds of consumers.

Registrant’s broadly identified goods or expansion of goods could be marketed under the same conditions and to the same target audience as Applicant’s more restricted goods. Applicant’s evidence and statements as to how Registrant currently sells its goods is not relevant; Registrant is entitled to the protection afforded it by its identification, which does not limit its channels of trade or consumers.

While Applicant maintains that “Registrant’s goods are sold through retail establishments,” whereas its “purchasers are highly skilled professionals...that must possess Applicant’s catalogue or must access Applicant’s website,”^[3] Applicant’s Brief, p. 10, there is no evidence in the record that Registrant’s marketing is limited in this manner, nor any evidence that Applicant sends catalogues only to those consumers that request them, or that access to its website is restricted to those working in the electronics industry.^[4] While Applicant states that both marks have been in use for many years with no instances of actual confusion, Applicant’s claim is unsupported by the evidence of record.^[5] As stated by the court in *In re Majestic Distilling Co., Inc.*, while “a showing of actual confusion would be highly probative, if not conclusive, of a high likelihood of confusion...[t]he lack of evidence of actual confusion carries little weight, especially in an ex parte context.” 315 F.3d 1311, 1317, 65 USPQ2d 1201 (Fed. Cir. 2003) (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value”).

2. Overlap exists between Applicant's customers and those of Registrant.

The relatedness of Applicant's goods and Registrant's goods is supported by the overlap among their potential customers. Applicant maintains that there is little to no likelihood of confusion because only those that specialize in the electronics industry would know of, or use, Applicant's goods. See Applicant's Brief, p. 10. However, it is axiomatic that those that specialize in the electronics field would also have use for Registrant's goods; i.e., an electrician would certainly have use for Registrant's screwdrivers or drills while performing electrical work, while also needing Applicant's wire strippers and blow torches. Purchasers who are sophisticated or knowledgeable in a particular field are not necessarily sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). As the court stated in *In re Shell Oil*, "even sophisticated purchasers can be confused by very similar marks." 992 F.2d 1204, 1208, 26 USPQ2d 1687 (Fed. Cir. 1993) (citing *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 1548, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990)).

In fact, contrary to Applicant's assertion that professionals in the electronics industry could not be confused due to a level of sophistication, case decisions have held that the fact that purchasers of products in the electronics industry are well informed, technically trained, and a discriminating group of people does not mean that they are immune from confusing products as to source when the marks applied thereto are similar. *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973); see also *In re Pellerin Milnor Corporation*, 221 USPQ 558, 560 (TTAB 1983) ("The law has long recognized that even technically sophisticated and careful purchasers of industrial equipment and products are not necessarily expert in trademark evaluation or immune from source confusion.").

Applicant also claims that potential purchasers of Registrant's product are "do-it-yourselfers." Applicant's Brief, p. 10. Even if it were true that Registrant's customer base were limited in this way (keeping in mind that the registration is not limited by target customer), by definition these consumers

are often unsophisticated at the various projects they attempt. This undercuts Applicant's argument that an unsophisticated purchaser in need of pliers or wire cutters for work around the house would not be confused by two companies with nearly identical names selling the tools that might needed to install a new home entertainment system; i.e., wire cutters or strippers from Applicant's identification, and pliers or screw drivers from Registrant. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (registrability is not based on evidence in the record regarding the class of purchasers to which sales of the goods are directed).

It should be noted that Applicant substantively misquotes the Court in *General Controls Co. v. Hi-G, Inc.*, 136 USPQ 570, 575 (D. Conn. 1962) in support of the argument that its goods are only purchased by sophisticated purchasers. Applicant quotes the Court as stating that "it would labor the obvious to explain that no one but a 'sophisticated' buyer would ever purchase [electronics' tools]" (bracket material inserted by Applicant; see Applicant's Brief, p. 9). However, what the Court actually said was that "it would labor the obvious to explain that no one but a 'sophisticated' buyer would ever purchase *a miniature relay*;" i.e., a complex device "sold to manufacturers for incorporation into complicated machines," and for which custom specifications were needed for various buyers (emphasis added). *General Controls Co.*, 136 USPQ at 575. This is certainly not the case with the goods identified by Applicant; i.e., hand tools such as wire cutters and tweezers. As with the *Bendix* case, Applicant has attempted to use the label "electronics" to assign a level of sophistication to its goods that is not evidenced by the record.

There is simply no evidence to suggest that an electrician who has use for Applicant's tweezers will not be confused by a highly similar mark for the company that sells him/her the pair of pliers needed for the same work. Of course, as discussed above, it is also true that consumers who are not professionals in the electronics industry may be looking for more specialized tools from Registrant and find themselves confused by the similar marks. Applicant applies the term "specialty electronics tools" to all of its identified goods, when, in reality, goods such as wire cutters and tweezers, are functional in other settings and not even distinguishable in name from common household tools of the

type in Registrant's identification.

CONCLUSION

For all of the foregoing reasons, the refusal of registration under Trademark Act § 2(d), 15 USC § 1052(d) should be affirmed.

Respectfully submitted,

/Ellen F. Burns/
Ellen F. Burns
Trademark Examining Attorney
Law Office 116
ellen.burns@uspto.gov
Phone: (571) 272-9098
Fax: (571) 273-9098

Meryl L. Hershkowitz
Managing Attorney

[1] The appeal in this case has been reassigned to the undersigned Examining Attorney, Ellen F. Burns, Law Office 116.

[2] Registration database record for Reg. No. 0568267, ALLIED, attached as Exhibit A.

[3] Applicant asserts that it "is a general consensus of consumers that specialty electronics tools are not sold in the same channels of trade as general home and garden tools." Applicant's Brief, p. 8. This is misleading at best. The five declarations Applicant cites as evidence for that conclusion are from employees in the electronics industry, who would represent only those already knowledgeable in the field, and hardly represent a "consensus of consumers." *See* Applicant's Brief, Exh. 4. Furthermore, of the five declarants, only one is identified as having technical responsibilities; the remaining four are in executive or planning positions with arguably less than relevant experience in distinguishing between trademarks used in connection with common hand tools such as pliers and wire cutters. *Id.*

[4] The declarations submitted by Applicant state merely that the declarant is "not aware of any hardware store that sells general hand tools for do-it-yourselfers that also contains specialized hand tools for use in the electronics industry." *See* Applicant's Brief, Exh. 4.

[5] The declarations submitted by Applicant contain no averments that there has been no confusion between the marks. *See* Applicant's Brief, Exh. 4.